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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,722

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Jean-Michel Santarella

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EXAMINER

REDDY, SATHAVARAM I

ART UNIT

PAPER NUMBER

1794

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,722	<b>Applicant(s)</b> SANTARELLA ET AL.	
	<b>Examiner</b> SATHAVARAM I. REDDY	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 9-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/21/2006</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-9, drawn to a product.

Group 2, claim(s) 10-18, drawn to a product.

Group 3, claim(s) 19-28, drawn to a product.

2. The inventions listed as Groups 1-3 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claims 1-22 lack unity of invention *a postiori* because the common technical feature is not applicant's contribution over the prior art as evidenced by Gustafson et al (US 6,251,512).

Gustafson et al (US 6,251,512) discloses a support paper printed on the face side and having a sealable layer on the reverse side and also on the face side a water vapour barrier layer comprising a mixture of acrylic polymers as an emulsion with a total acid number between 30 and 200 and 0% by weight of wax (col. 3, lines 64-67; col. 4, lines 1-3; col. 4, lines 8-33; col. 4, lines 53-67; col. 5, lines 1-17; and col. 5, lines 53-64). The support paper of Gustafson et al (US 6,251,512) can be a backing for an adhesive

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composition thus having an adhesive composition on the reverse side of the support paper.

3. During a telephone conversation with Bryan Davidson on 1/21/2009 a provisional election was made with traverse to prosecute the invention of Group 1, claim1-8.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 9-22 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by humid matter. Is it matter that contains water or is wet?

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**8. Claims 1 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al (US 6,251,512) in view of Torigoe et al (US 5,236,767).**

Gustafson et al (US 6,251,512) discloses a support paper having a sealable layer on the reverse side and also on the face side a water vapour barrier layer comprising a mixture of acrylic polymers as an emulsion with a total acid number between 30 and 200 and 0% by weight of wax (col. 3, lines 64-67; col. 4, lines 1-3; col. 4, lines 8-33; col. 4, lines 53-67; col. 5, lines 1-17; and col. 5, lines 53-64). The support paper of Gustafson et al (US 6,251,512) can be a backing for an adhesive composition thus having an adhesive composition on the reverse side of the support paper.

Gustafson et al (US 6,251,512) does not appear to explicitly disclose a printed layer on the face side of a support paper.

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However, Torigoe et al (US 5,236,767) discloses a printed layer on the face side of a support paper (col. 3, lines 4-27).

Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) are analogous art because they are from the same field of barrier papers.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) to include the printed layer of Torigoe et al (US 5,236,767) in that having the required printed layer is preferable in that it has durability and satisfactory image quality (col. 1, lines 47-51).

Regarding claim 5, Gustafson et al (US 6,251,512) discloses a sealable layer in contact with the whole part of the reverse side of the support paper (col. 5, lines 53-64). The support paper of Gustafson et al (US 6,251,512) can be a backing for an adhesive composition thus having an adhesive composition on the reverse side of the support paper.

Regarding claim 6, Gustafson et al (US 6,251,512) discloses the mixture of acrylic polymers as an emulsion containing styrene acrylic polymers (col. 4, lines 8-33).

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Regarding claim 7, Gustafson et al (US 6,251,512) discloses the mixture of acrylic polymers containing 0 to 90% by weight of resin (col. 4, lines 53-64). The ratio of polymer particles to the binder is 0.1 to 1 thus the resin is 0 to 90% by weight.

**9. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al (US 6,251,512) in view of Torigoe et al (US 5,236,767) and further in view of Salste et al (US 2002/0136878).**

Gustafson et al (US 6,251,512) discloses a support paper having a sealable layer on the reverse side and also on the face side a water vapour barrier layer comprising a mixture of acrylic polymers as an emulsion with a total acid number between 30 and 200 and 0% by weight of wax (col. 3, lines 64-67; col. 4, lines 1-3; col. 4, lines 8-33; col. 4, lines 53-67; col. 5, lines 1-17; and col. 5, lines 53-64). The support paper of Gustafson et al (US 6,251,512) can be a backing for an adhesive composition thus having an adhesive composition on the reverse side of the support paper.

Gustafson et al (US 6,251,512) does not appear to explicitly disclose a printed layer on the face side of a support paper and an oxygen and aroma barrier layer of ethylene vinyl alcohol or polyvinyl alcohol with 1 to 8 g/m<sup>2</sup> of dry matter and positioned between a support paper and a sealable layer.

However, Torigoe et al (US 5,236,767) discloses a printed layer on the face side of a support paper (col. 3, lines 4-27).

Salste et al (US 2002/0136878) discloses an oxygen and aroma barrier layer of ethylene vinyl alcohol or polyvinyl alcohol with 1 to 8 g/m<sup>2</sup> of dry matter and positioned between a support paper and a sealable layer (paragraphs [0010] and [0017]). The ethyl vinyl alcohol layer (Fig. 1 #5) of Salste et al (US 2002/0136878) is between the support paper (Fig. 1 #3; "cardboard") and a sealable layer (Fig. 1 #6; "adhesive").

Salste et al (US 2002/0136878) and the claims differ in that the dry matter of the ethyl vinyl alcohol barrier layer does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Salste et al (US 2002/0136878) overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

"The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).



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Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Gustafson et al (US 6,251,512), Torigoe et al (US 5,236,767) and Salste et al (US 2002/0136878) are analogous art because they are from the same field of barrier papers.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) to include the printed layer of Torigoe et al (US 5,236,767) in that having the required printed layer is preferable in that it has durability and satisfactory image quality (col. 1, lines 47-51).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512) and Salste et al (US 2002/0136878) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) to include the ethyl vinyl alcohol barrier layer of Salste et al (US 2002/0136878) in that having an ethyl vinyl alcohol barrier layer provides excellent adhesion to paper or cardboard (paragraph [0009]).

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Regarding claim 9, Gustafson et al (US 6,251,512) does not appear to explicitly disclose the ethyl vinyl alcohol or polyvinyl alcohol being 100% dry weight of the layer.

However, Torigoe et al (US 5,236,767) discloses the ethyl vinyl alcohol or polyvinyl alcohol being 100% dry weight of the layer (col. 3, lines 4-27).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) to include the 100% dry weight of the layer of Torigoe et al (US 5,236,767) in that having such a characteristic for a barrier layer protects the surface of an image and prevents it from being damaged (col. 3, lines 4-27).

**10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al (US 6,251,512) in view of Torigoe et al (US 5,236,767) and further in view of Salste et al (US 2002/0136878).**

Gustafson et al (US 6,251,512) discloses a support paper having a sealable layer on the reverse side and also on the face side a water vapour barrier layer comprising a mixture of acrylic polymers as an emulsion with a total acid number between 30 and 200 and 0% by weight of wax (col. 3, lines 64-67; col. 4, lines 1-3; col. 4, lines 8-33; col. 4, lines 53-67; col. 5, lines 1-17; and col. 5, lines 53-64). The support paper of

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Gustafson et al (US 6,251,512) can be a backing for an adhesive composition thus having an adhesive composition on the reverse side of the support paper.

Gustafson et al (US 6,251,512) does not appear to explicitly disclose a printed layer on the face side of a support paper and an oxygen and aroma barrier layer comprising 50% to 1000 by weight of ethylene vinyl alcohol or polyvinyl alcohol positioned between a support paper and a sealable layer.

However, Torigoe et al (US 5,236,767) discloses a printed layer on the face side of a support paper (col. 3, lines 4-27) and 50% to 100% by weight of ethylene vinyl alcohol or polyvinyl alcohol.

Salste et al (US 2002/0136878) discloses an oxygen and aroma barrier layer of ethylene vinyl alcohol or polyvinyl alcohol with 1 to 8 g/m<sup>2</sup> of dry matter and positioned between a support paper and a sealable layer (paragraphs [0010] and [0017]). The ethyl vinyl alcohol layer (Fig. 1 #5) of Salste et al (US 2002/0136878) is between the support paper (Fig. 1 #3; "cardboard") and a sealable layer (Fig. 1 #6; "adhesive").

Gustafson et al (US 6,251,512), Torigoe et al (US 5,236,767) and Salste et al (US 2002/0136878) are analogous art because they are from the same field of barrier papers.

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At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) to include the printed layer of Torigoe et al and to include the 50% to 100% dry weight of the oxygen aroma barrier layer of Torigoe et al (US 5,236,767) in that having the required printed layer is preferable in that it has durability and satisfactory image quality (col. 1, lines 47-51) and having such a characteristic for a barrier layer protects the surface of an image and prevents it from being damaged (col. 3, lines 4-27).

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512) and Salste et al (US 2002/0136878) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) to include the ethyl vinyl alcohol barrier layer of Salste et al (US 2002/0136878) in that having an ethyl vinyl alcohol barrier layer provides excellent adhesion to paper or cardboard (paragraph [0009]).

**11. Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) in view of Williams et al (US 2003/0008116).**

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Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) discloses the invention as claimed in claim 1.

Regarding claim 4, Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) does not appear to explicitly disclose a water vapour barrier layer having a mass between 2 and 10 g/m<sup>2</sup>.

However, Williams et al (US 2003/0008116) discloses a water vapour barrier layer having a mass between 2 and 10 g/m<sup>2</sup> (paragraph [0052]).

Regarding claim 8, Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) does not appear to explicitly disclose a water vapour having 100% by dry weight of the resin.

However, Williams et al (US 2003/0008116) discloses a water vapour barrier layer having 100% by dry weight of the resin (paragraph [0048]).

Gustafson et al (US 6,251,512), Torigoe et al (US 5,236,767) and Williams et al (US 2003/0008116) are analogous art because they are from the same field of barrier papers.

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At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Gustafson et al (US 6,251,512), Torigoe et al (US 5,236,767) and Williams et al (US 2003/0008116) before him or her, to modify the barrier paper of Gustafson et al (US 6,251,512) and Torigoe et al (US 5,236,767) to include the mass and 100% dry weight of Williams et al (US 2003/0008116) in that having a barrier layer with such characteristics would not transfer residue to an image and would provide a water barrier that prevents penetration of the support (paragraph [0108]).

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wolinski et al (US 3,864,181), Beeson et al (US 5,102,699), Overcash et al (US 5,603,996), Gosh et al (US 5,935,903), Hare (US 2002/0008381), and Qiao et al (US 2002/0018969).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SATHAVARAM I. REDDY whose telephone number is (571) 270-7061. The examiner can normally be reached on 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SIR

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794